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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/770,292

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Mitsutaka Nagao

P20533

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08/13/2004

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EXAMINER

LETT, THOMAS J

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,292

Applicant(s)

NAGAO ET AL.

Examiner

Thomas J. Lett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3, 4, and 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because the term "Sbuject" should be changed to read "Subject" in Fig. 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: the term "transmits" should be changed to read "transmit" (p6, line 4).

Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: the term "IAFX" should be changed to read "IFAX" (p7, line 23).

Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: the term "performs" should be changed to read "perform" (p7, line 27).

Appropriate correction is required.

5. The disclosure is objected to because of the following informalities: the sentence beginning with "In addition, ..." is not complete (p9, lines 19-21).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 3, 7, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (US Patent 6,603,569 B1).

With respect to claim 3, Johnson et al discloses a facsimile interface unit 200 capable of connection to a plurality of communication lines (see Fig. 3), which reads on

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a facsimile communication section which has a plurality of the same or different types of network channels to be used in facsimile communication;

facsimile interface unit 200 receives the email signal from the internet (col 4, lines 56-57), or can direct the email towards a computer network where the computer network may be a combination of LANs, wide area networks ("WANs"), intranets, internets, second generation internets, and other networks (col 4, lines 42-45), which reads on an e-mail communication section which transmits/receives e-mail which is subjected to relay request.

facsimile interface unit 200 contains a microprocessor 420 containing software element 520 contains programs for providing functions such as conversion and distribution of data (col 6, lines 42-46), which reads on a channel selecting section which selects a channel used to facsimile-transmit image in accordance with channel selection information;

the fax interface unit 200 receives dual tone multiple frequency ("DTMF") tones from the fax machine, a table lookup procedure is initiated and associates an email address with the identifier. A communication path is then selected based on the email address (col 3, lines 58-66), which reads on a channel selecting section which specifies said network channel to be used with reference to said channel selection information table based on said channel selection information when e-mail, which includes said channel selection information and dial information of transmission destination, is received, wherein said facsimile communication section uses said specified network

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channel to facsimile-transmit image information of said received e-mail to said dial information.

With respect to claim 7, Johnson et al discloses a facsimile interface unit 200 can generate emails directed towards a computer network where the computer network may be a combination of LANs, wide area networks ("WANs"), intranets, internets, second generation internets, and other networks (col 4, lines 41-45 and see Fig. 3), which reads on said plurality of network channels is network channels corresponding to PSTN and ISDN.

With respect to claim 8, Johnson et al discloses a facsimile interface unit 200 can generate emails directed towards a computer network where the computer network may be a combination of LANs, wide area networks ("WANs"), intranets, internets, second generation internets, and other networks (col 4, lines 41-45 and see Fig. 3), which reads on said plurality of network channels is network channels for performing outside-line communication using PSTN or ISDN and network channels for performing internal-line communication using LAN.

With respect to claim 9, Johnson et al discloses a facsimile interface unit 200 can generate emails directed towards a computer network where the computer network may be a combination of LANs, wide area networks ("WANs"), intranets, internets, second generation internets, and other networks (col 4, lines 41-45 and see Fig. 3), which reads on said plurality of network channels is network channels which perform G3 facsimile communication and network channels which perform G4 facsimile communication.

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7. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (US Patent 6,603,569 B1). Johnson et al discloses in FIG. 3 a block diagram of a fax transmission system having a plurality of communication channels (col 2, lines 19-20), which reads on a channel selecting method in a facsimile relay apparatus in which a plurality of the same or different types of channels is usable,

and, a communication path, several are illustrated in FIG. 3, within internet 210 is selected based on the email address (col 3, lines 64-66), which reads on said channel selecting method selects a channel to be used in facsimile-transmitting image information included in e-mail subjected to relay request in accordance with channel selection information included in said e-mail. This email message may be relayed to a printer or other destination as described throughout the invention of Johnson et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami (US Patent 5,719,688 A) in view of Toyoda (US Patent 6,094,277 A). Kagami discloses a facsimile apparatus (Fig. 1) capable of connecting a plurality of communication lines, which reads on a facsimile communication section which has a

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plurality of the same or different types of network channels to be used in facsimile communication;

and an operation unit 7 storing a control program to control operating units 10 and 13 (col 3, lines 23-26), which reads on a channel selecting section which selects a channel used to facsimile-transmit image in accordance with channel selection information.

Kagami does not disclose expressly an e-mail communication section which transmits/receives e-mail which is subjected to relay request. Toyoda discloses an Internet facsimile apparatus comprising transmitting/receiving means for transmitting/receiving E-mail to/from a network (col 1, lines 65-67). Toyoda also discloses the granting of password=password only to the users who are authorized to use the Internet FAX as a relay apparatus prevents unauthorized use by other people. E-mail is sent to a mail server in which a mailbox of the destination terminal, e.g., Internet FAX or PC, is set (col 3, lines 48-54). Kagami and Toyoda are analogous art because they are from the similar problem solving area of data communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the email communication feature of Toyoda to Kagami in order to obtain an apparatus capable of transmitting/receiving email subject to a relay request. The motivation for doing so would be to have the capability to process both email and facsimile forms of data.

With respect to claim 2, Kagami does not disclose expressly a different relay password to permit relay is fixed for each of said channels and said facsimile apparatus

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uses said relay password as said channel selection information. Toyoda discloses the granting of password=password only to the users who are authorized to use the Internet FAX as a relay apparatus prevents unauthorized use by other people. E-mail is sent to a mail server in which a mailbox of the destination terminal, e.g., Internet FAX or PC, is set (col 3, lines 48-54). Kagami and Toyoda are analogous art because they are from the similar problem solving area of data communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add this relay password in combination with the channel selecting method of Kagami to select a channel using a distinct password prior to transmission of data to select the channel. The motivation for doing so would be to have the capability to select a channel based on information in an email.

Allowable Subject Matter

9. Claims 4, 5, and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

TJL



MARK WALLERSON
PRIMARY EXAMINER

